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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR      | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|---------------------------|---------------------|------------------|
| 10/629,451      | 07/29/2003  | Ruediger Friedrich Berger | DE920010039US1      | 5729             |

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EXAMINER

TZENG, FRED

ART UNIT PAPER NUMBER

2651

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                               |  |
|------------------------------|-------------------------------|-------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/629,451 | Applicant(s)<br>BERGER ET AL. |  |
|                              | Examiner<br>Fred Tzeng        | Art Unit<br>2651              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-23 are presented for examination.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Drawings***

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

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requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-15, 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Melzer et al (USPN 6,346,992), hereafter as Melzer.

RE claims 1, 4 and 20, Melzer discloses an apparatus for precisely positioning a medium (see figure 1), comprising: a spindle configured for mounting the medium on the spindle (see column 6 lines 25-28; i.e., the spindle 10 configured for mounting the medium 18); a device coupled to the spindle for rotating the spindle to change the angular position of the medium with respect to a predefined reference position (see column 6 lines 17-24; i.e., the stepper motor 16 coupled to spindle 10 for rotating the spindle 10); and a friction element proximate the spindle, the friction element for braking the spindle at a predetermined position and not allowing a swing back (see column 6 lines 28-31 and column 3 lines 40-54; i.e., the friction clutch 20 for braking the spindle,

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such that no resonances can appear and no mechanical oscillation will be excited, and not allowing a swing back).

RE claim 2, Melzer discloses that the device comprises a stepper motor (see column 6 lines 17-31; i.e., the stepper motor 16).

RE claim 3, Melzer discloses the friction element comprises a bar adapted to be pressed against the spindle (see column 6 lines 28-31; the friction clutch 20).

RE claims 5, 9-12, Melzer discloses that the bar comprises a flexible spring (see figure 1 and column 10 lines 8-19).

RE claim 6, Melzer discloses a relay, wherein the bar is connected to the relay (see figure 1).

RE claim 7, Melzer discloses that the relay is software-controllable (see column 7 lines 29-50 and column 1 lines 46-56).

RE claim 8, Melzer discloses that the bar comprises a flexible spring, and further comprising an air pressure cylinder, wherein the flexible spring is connected to the air pressure cylinder (see column 7 lines 29-50 and column 6 lines 8-11).

RE claims 13 and 14, Melzer discloses means for adjusting a force with which the bar is pressed against the spindle (see column 10 lines 38-64).

RE claim 15, Melzer discloses that the medium comprises a magnetic disk (see figure 1; i.e., the disk 18).

Claims 21-23 are the method steps associated with the apparatus of claims 1-15, 20 and therefore are rejected on the same basis as the apparatus claims.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being obvious over Melzer et al (USPN 6,346,992) in view of the applicants' admitted prior art, hereafter as AAPA.

RE claims 16-19, Melzer discloses the invention substantially as claimed.

However, Melzer does not specifically disclose that the medium comprises a magnetic tape, or a optical filter, or a len, or a mirror.

AAPA teaches that the medium mounted on a spindle can include a magnetic tape, or a optical filter, or a len, or a mirror (see page 1 lines 7-15).

Melzer and AAPA are combinable because they are from the same field of endeavor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Melzer invention by including a magnetic tape, or a optical filter, or a len, or a mirror as its medium in order to make full usage of the Melzer's inventive concept.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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10. Any inquiry concerning this communication from the examiner should be directed to Fred Tzeng whose telephone number is 571-272-7565. The examiner can normally be reached on weekdays from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-7565 for After Final communications.

11. Informal regarding the status of an application may be obtained from the Patent Application Information Retrieval (**PAIR**) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Fred Tzeng", with a stylized flourish at the end.

Fred F. Tzeng

December 17, 2005